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Patent**REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-22 are pending in the application. Claims 1-22 have been amended. New claims 23-42 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. Assignee asserts that no prosecution history estoppel should result from the above amendments where the amendments were made to clarify Assignee's claims and/or broaden scope of the amended claims.

**Claim rejections – 35 USC §103(a)**

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art from the Background section of the present application (hereinafter the "Background"). These rejections are respectfully traversed.

Assignee respectfully submits that, the Background does not teach or suggest the limitation of independent claim 1 reciting "*using a preset calibration parameter to perform compensation and calibration for the captured image*". The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

The Examiner asserts that the Background discloses:

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Regarding claim 1, which is representative of claim 8, Applicant admits an image scanning method for a scanner which has a preset constant calibration parameter located therein ... using the preset calibration parameter to perform compensation and calibration for the captured image 132 ... (Figs 1A and 1B). (See page 3 of the Office Action.)

The Assignee cannot agree. First, Assignee notes that independent claim 1 recites a "*preset calibration parameter*" while independent claim 8 has no such recitation. Accordingly, at the very least the doctrine of claim differentiation demands that "*preset*" term of claim 1 be given a meaning by the Examiner. Here, the Examiner has failed to establish that the calibration parameter discussed in the Background would be understood by one of ordinary skill in the art to teach or suggest a "*preset calibration parameter*" as is recited in claim 1. For example, the Background notes that the process of Fig. 1B involves:

[T]he image scanning process of a scanner adapted a conventional technique includes ... performing a pre-scanning process and calculating the calibration parameters 132 ... [a]lthough the calibration process may enable the scanner to get a better scanning quality for every scanning operation, the calibration process takes a lot of time. (See paragraphs [0005-0006] of the Background.)

Conversely, without limiting the claims to any single embodiment or reading limitations from the specification into the claims, the specification notes that:

[T]he calibration parameters may be directly stored in the Read Only Memory (ROM) or systems file at the plant site before shipment. Therefore the scanner of this system does not have to perform calibration process for deriving the calibration parameters before every scanning operation, and may directly perform image scanning on the scanning object through the control module or system file to fetch the calibration parameters. (See paragraph [0024] of the Specification.)

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Accordingly, Assignee respectfully submits that the Examiner is not giving a "*preset calibration parameter*" as is recited in claim 1 its clear meaning as would be understood to one of ordinary skill in the art. Instead the Examiner appears to be reading the recited "*preset calibration parameter*" as merely a "calibration parameter", thus impermissibly disregarding the explicit claim term of "*preset*". In the absence of the Examiner pointing to such a disclosure in the Background, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the Background renders obvious all of the features of claim 1.

Regarding independent claim 8, Assignee respectfully submits that, the Background does not teach or suggest the limitation of independent claim 8 reciting "*performing one or more subsequent scanings of one or more subsequent scanning objects without performing a subsequent pre-scanning calibration*", which Assignee submits is essentially equivalent to the prior limitation of "*repeating the step b*". Here, the Examiner has failed to establish *prima facie* obviousness as the prior rejection did not address this limitation of the method of claim 8 in any way. In the absence of the Examiner pointing to such a disclosure in the Background, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the Background renders obvious all of the features of claim 8.

Claims 2-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Wieloch (U.S. Patent No. 5,764,023). These rejections are respectfully traversed.

Assignee respectfully submits that, the Examiner has not established that the proposed combination of admitted prior art in view of Wieloch teaches or suggests "*storing a preset*

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*calibration parameter via a control module comprising a read only memory (ROM) and using the stored calibration parameter to perform compensation and calibration for the captured image*" as recited in dependent claim 2. The Examiner asserts that Wieloch discloses:

Wieloch discloses a control module having a read only memory (ROM) for storing a preset calibration parameter and using the stored calibration parameter to perform compensation calibration for the captured image (Col 7 Lines 52-66). (See page 4 of the Office Action.)

This statement is false on its face since the patent to Wieloch nowhere mentions anything about a captured image. In fact, a text search of US Patent No. 5,764,023 as obtained from the USPTO website was performed, and the words "capture", "captured", and "image" were not found to exist in the patent. In the absence of the Examiner pointing to such a disclosure in the proposed combination, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the proposed combination renders obvious all of the features of claim 2.

Furthermore, the Examiner has asserted that the proposed combination is proper, arguing that:

Admitted prior art & Wieloch are combinable because they are from applications, which require control options. (See page 4 of the Office Action.)

Assignee has previously respectfully submitted that this is simply too vague of a basis to establish any motivation to combine the alleged admitted prior art with the teachings of the patent to Wieloch. In response, the Examiner has argued that:

In response to applicant's argument that Wieloch is nonanalogous ... Wieloch is used to store a "calibration parameter to perform compensation and calibration for the captured image". (See page 2 of the Office Action.)

The Examiner is kindly reminded that:

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The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). (See MPEP § 2141.01(a))

Here, Assignee again respectfully submits that the Examiner's alleged quotation from Wieloch is false on its face since the patent to Wieloch nowhere mentions anything about a "captured image", "capture", "captured", and/or "image" as asserted by the Examiner. It should be noted that the present invention relates to an image scanning system and method for a scanner, whereas the patent to Wieloch relates to the field of motor controllers for driving alternating current motors. The applicant respectfully traverses the assertion that one of ordinary skill in the art of image scanning systems would turn to the field of ac motors for motivation to arrive at the claimed invention, or specifically to the field of ac motors to arrive a method for scanning an image to determine how to store a calibration parameter *"to perform compensation and calibration for the captured image"* as recited, for example, in claim 2. In other words, it appears that any calibration discussed in the patent to Wieloch has nothing to do with the calibration of an image captured by a scanner, and in any event, the Examiner did not establish that calibration of an ac motor as disclosed in Wieloch is the same and/or analogous to calibration of a captured image as recited in the present claims. Thus, contrary to the Examiner's assertion, the patent to Wieloch appears to be directed to subject matter, namely ac motors, that is nonanalogous to the subject matter of the claimed invention, namely image scanning systems. Therefore, since the patent to Wieloch appears to disclose subject matter that is nonanalogous to the present invention, one having skill in the art of image scanning systems would not be motivated to combine an image scanning system with the ac motor of Wieloch to arrive at a

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combination that performs compensation and calibration of a captured image. As a result, the patent to Wieloch cannot support a rejection under § 103, so the rejection to claim 2 should be withdrawn. Claims 3-7 and 9-14 are similarly not obvious, at least on the same or similar basis as claim 2. Additionally, claims 2-7 are similarly not obvious, at least on the same or similar basis as claim 1; while claims 9-14 are similarly not obvious, at least on the same or similar basis as claim 8.

Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Spitz (U.S. Patent No. 5,939,697). These rejections are respectfully traversed.

Assignee respectfully submits that, the proposed combination of Spitz with the Background does not teach or suggest the limitation of independent claim 15 reciting *"judging if a calibration parameter is stored and calculating a calibration parameter if no calibration parameter is stored"*. In the Office Action, the Examiner has asserted that:

Spitz discloses expressly a) judging if a control module having a calibration parameter is required; b) providing a scanning object if the outcome of the step a) is positive; wherein the following steps are performed when the outcome of step a) is negative: a1) performing pre-scanning and calculating calibration parameter; and a2) storing the calibration parameter in the control module (Col 8 Lines 19-28). (See page 6 of the Office Action.)

The Assignee cannot agree. Specifically, the Examiner has failed to point to any portion of Spitz teaching or suggesting calculating a calibration parameter *"if no calibration parameter is stored"*, as recited in claim 15. In the absence of the Examiner pointing to such a disclosure in proposed combination, Assignee requests that the rejection be withdrawn as the Examiner failed

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to establish that proposed combination renders obvious all of the features of claim 15. Claim 16 is similarly not obvious, at least on the same or similar basis as claim 15.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art and Spitz '697 in view of Wieloch '023. These rejections are respectfully traversed.

As discussed, above, since the patent to Wieloch appears to disclose subject matter that is nonanalogous to the present invention, one having skill in the art of image scanning systems would not be motivated to combine an image scanning system with the ac motor of Wieloch to arrive at a combination that performs compensation and calibration of a capture image. As a result, the patent to Wieloch cannot support a rejection under § 103, so the rejection should be withdrawn. Additionally, claims 17-22 are similarly not obvious, at least on the same or similar basis as claim 15.

New claims 23-42 have been added. New claims 23-25 and 33-35 are novel and not obvious at least on the same or similar basis as claim 1. New claims 26-28 and 36-38 are novel and not obvious at least on the same or similar basis as claim 8. New claims 29-32 and 39-42 are novel and not obvious at least on the same or similar basis as claim 15.

It is noted that claimed subject matter may be patentably distinguished from the cited reference for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the

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Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.



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**Conclusion**

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

**Invitation for a Telephone Interview**

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,  
Attorney for Assignee

Dated: October 30, 2006

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